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Reply Brief  
#9

4/16/03  
B. Ross

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*Albert W. Watkins*

April 11, 2003

Signature

Date

In re:

Serial #: 09/589,866

For: Tag-Along Teacher Educational Aids

Filed: June 8, 2000

Inventor: Lorna B. Voit

GAU: 3712

Examiner: Nguyen, Kien T.

Docket #: Voit Tag

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TECHNOLOGY CENTER R3700

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REPLY BRIEF

The primary issue before the Board appears to appellant's representative to be whether Luciano provides a teaching for the use of a key in combination with the disclosed key ring and "handheld microprocessor chip reader" (Luciano's words, column 2, lines 22-23, which states "microprocessor chips 17 are secured to or embedded in outer marginal edge portions 19 of each page 17, and they are thus positioned for being read by a handheld microprocessor chip reader as illustrated in FIGS. 2 and 3"). Contrary to the Examiner's statement, the burden is not upon the appellant to address whether the references might be combined together. Rather, as set forth by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), the test for obviousness under section 103 includes a determination of the scope and content of the prior art; ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art. The burden is upon the Examiner to consider each of the steps set

forth therein in the presentation of a rejection based upon obviousness.

Appellant recites the combination key, key ring and educational tag in all independent claims. Since neither Luciano nor Peckham explicitly illustrates the use of a key in the combination recited by the appellant, then, in order for the Examiner's rejection to carry the burden of obviousness, there must be a teaching within the references that would lead one of ordinary skill in the art to the claimed combination. Since Peckham is devoid of anything which might remotely be considered portable or affiliated with a key, and provides no teachings thereto, then the question of whether the teaching necessary in the present case appears to hinge on whether Luciano in fact teaches the use of a key in his illustrated combination of key ring with the handheld microprocessor chip reader. Since this appears to appellant and her representative to be the central issue, this is where the primary focus of the appellant's arguments have been directed.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is not suggestion or motivation to make the proposed modification *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The Examiner proposes that Luciano, by virtue of reciting a key ring, suggests or teaches implicitly the use of a key in further combination. In contrast, the appellant has described very clearly why the use of a key in Luciano would render the Luciano device inoperative. Since Luciano would be inoperative, one of ordinary skill would not reasonably obtain from Luciano a teaching of the use of a key in combination with the educational tag. If Luciano does not teach the claim recitation, and Peckham does not even remotely teach or suggest the same, then what is the basis for the present rejection?

The Examiner alleges that there would be no other reason to use the word key ring, if Luciano did not intend the combination with keys. The Board is respectfully requested to consider the true magnitude of the Examiner's statement. Plumber's putty is regularly used to fill gaps in roofing structures. Does the reference to using plumber's putty on the roof teach the combination of a drain pipe with roofing shingles? Of course not. In fact, the patent files are replete with references to common structures and components that are able to fulfill the desired role. These references do not require or even teach additional components any more than the use of plumber's putty requires a kitchen sink.

A quick search, using the incredible web-site provided by the Patent Office, with the search terms "keyring or 'key ring'" yielded the following recent patents. The Board will recognize that these patents were only pulled from the first ten or fifteen patents, and that there are literally

thousands more that discuss the use of key rings:

6,546,202 entitled "Lens driving apparatus" describes a camera lens system. "Also, as shown in FIG. 5, a shutter unit 91 is accommodated in the third cylinder 6. The shutter unit 91 is formed as a unit assembled with a shutter 92 and a second lens group 102. A first lens group 101 is disposed in front of the shutter unit 91 in the third cylinder 6, whereas a third lens group 103 is disposed behind the shutter unit 91. The first lens group 101 is secured within the third cylinder 6 as being attached to a first lens frame 104. The third lens group 103 is secured within the third cylinder 6 as being attached to a third lens frame 106. A translation key ring 111 is attached to the rear part of the third cylinder 6. In the translation key ring 111, a ring part 112 is formed with an axially extending key part 113. The translation key ring 111 is installed such that the key part 113 is inserted into the third cylinder 6. The outer periphery of the rear part of the translation key ring 111 is formed with a flange 114 projecting outward. The flange 114 is formed greater than the inside diameter of the second cylinder 5 and engages the rear end of the second cylinder 5."

6,533,468, entitled "Universal optical fiber connectors and basic plugs thereof" describes fiber optic connectors: "A FC-type plug as an example of such conventional optical fiber connector is depicted in FIG. 24. As shown in the figure, the FC-type plug comprises a ferrule 101, a frame 102, and a tightening member 103, with an integrated configuration of coaxially arranging these elements around a bare optical fiber 99 as the center thereof. Furthermore, there is a key ring 104 oriented along a direction of a displacement of the center of the bare optical fiber 99 fixed in the ferrule 101."

6,531,107, entitled "Fabrication of molecular nanosystems", describes molecular chemistry: "We have now successfully completed the high yield synthesis of the key ring closed intermediate [(C.sub.2 H.sub.10 H.sub.10).sub.2 CH(OH)] using the pathway shown in FIG. 3."

Why would any of these authors have chosen to describe using the words "key ring"? Because key rings are ubiquitous, and using the descriptor immediately details the mechanical structure which one considers suitable for an application without having to elaborate on the spiral winding or the method of attachment or removal from an object. This does not imply or mandate or, in the opinion of the appellant with regard to Luciano, teach the further inclusion of a key with the key ring. Were the key a necessary affiliation or teaching with a key ring, then the camera shutter and fiber optic connector would be rather useless, and a molecular nanosystem including a key would be most, shall we say, interesting.

While the present reply brief is intended to bring to the attention of the Board what appears to be the central issue in the present appeal, the Board is respectfully requested to consider all matters raised by the appellant in the reply brief, and recognize that the appellant's representative does still rely upon the appeal brief and has not waived any of the arguments contained therein.

While no fees are believed to be required, the commissioner is authorized to charge any fees associated with this reply brief to deposit account 17-0155.

Sincerely,

A handwritten signature in black ink, appearing to read "Albert W. Watkins", with a stylized flourish at the end.

Albert W. Watkins

reg. 31,676